



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,416	05/27/2005	Marie-Claire Grosjean-Cournoyer	05394.0021	6878
22852 7590 05/16/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER JOIKE, MICHELE K	
			ART UNIT 1636	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,416

Applicant(s)

GROSJEAN-COURNOYER ET AL.

Examiner

Michele K. Joike, Ph.D.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-79, claim(s) 1-13, 26, drawn to a nucleic acid encoding an essential for growth (EFG) polypeptide, a polypeptide, an expression cassette, and a host cell, and the method of identifying a candidate inhibitor. *Applicant needs to pick a nucleic acid sequence and an amino acid sequence. Each group represents a nucleic acid sequence and an amino acid sequence. For example, Group 1 would contain SEQ ID NOs: 3 and 1. However, the amino acid sequence should be encoded by the nucleic acid.

Group 80, claim(s) 14-20, drawn to a method of locating at least one gene essential for the growth of a haploid fungus.

Group 81, claim(s) 21, drawn to plasmid pNlpyr.

Group 82, claim(s) 22-24, drawn to diploid strains.

Group 83, claim(s) 25, drawn to a method for screening compounds that are active against *A. fumigatus*.

Group 84-124, claim(s) 27-29, drawn to a composition capable of inhibiting haploid fungal growth. *Applicant needs to pick a nucleic acid sequence. Each group represents a nucleic acid sequence.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical features of Groups 1-79 differ because nucleotide and/or

amino acid sequences comprise the groups. However, each is a different sequence. The protein sequences are structurally and functionally unrelated to the nucleic acid sequences. Each specific nucleic acid sequence is biochemically distinct from each of the other nucleic acid sequences and each of the protein sequences is structurally and functionally distinct from the other protein sequences.

Furthermore, the new guidelines with regard to nucleotide sequence searches was published as a pre-OG notice on March 27, 2007, and available at

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/sequence02212007.pdf>.

This notice rescinds the 1996 OG Notice that provided for a partial waiver of the requirements for restriction practice by permitting examination of a reasonable number, up to ten, independent and distinct polynucleotide molecules in a single 35 USC 111(a) or 35 USC 371 application (see 1192 Off. Gaz. Pat. Office 68, No. 19, 1996).

The Office decision to rescind the 1996 waiver is based upon the increasing computational, search and examination burden required for the consideration of nucleic acid sequences, and complexity of claims drawn to such, compared to the time of the 1996 waiver (see the statistics cited in the pre-OG Notice at the link above).

Therefore, in accordance with 37 CFR 1.499, Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

The special technical feature of Group 80 is a method of locating at least one gene essential for the growth of a haploid fungus. This special technical feature is different from the special technical feature of Groups 1-79 because it represents a method of locating at least one gene essential for the growth of a haploid fungus as

Art Unit: 1636

opposed to being a DNA sequence, amino acid sequence or a method of identifying an inhibitor. The methods consist of unrelated and different steps and materials (i.e. the method in Group 80 involves generating a diploid strain and mutagenizing it), and there is a different outcome for each method since a gene is located versus an inhibitor of the DNA sequence being identified.

The special technical feature of Group 81 is a plasmid. This special technical feature is different from the special technical feature of Groups 1-80 because it is a plasmid as opposed to a gene encoding a polypeptide, an amino acid sequence or a method of identifying an inhibitor. Each specific nucleic acid sequence is biochemically distinct from each of the other nucleic acid sequences, and in this case, a plasmid versus a gene encoding a protein.

The special technical feature of Group 82 is diploid strains. This special technical feature is different from the special technical feature of Groups 1-81 because the special technical feature is the strains as opposed to a plasmid, a gene encoding a polypeptide, an amino acid sequence or a method of identifying an inhibitor. A host cell is an organism and is different that nucleic acid and amino acid sequences.

The special technical feature of Group 83 is a method for screening compounds that are active against *A. fumigatus*. This special technical feature is different from the special technical feature of Groups 1-82 because it represents a method of screening compounds as opposed to a DNA sequence, amino acid sequence, host cell or a method of identifying an inhibitor, and consists of unrelated and different steps and

Art Unit: 1636

materials (i.e. this method involves comparing effects of candidate compounds in heterozygous and homozygous strains.)

The special technical feature of Groups 84-124 is a composition capable of inhibiting haploid growth. This special technical feature is different from the special technical feature of Groups 1-83 because the composition can be a fungicidal composition as opposed to a plasmid, a gene encoding a polypeptide, an amino acid sequence or a method of identifying an inhibitor, etc.. A fungicidal is a biocidal agent and differs from the sequences, strains and methods mentioned above.

Because of the reasons set forth above, the inventions have different special technical features and are therefore patentably distinct.

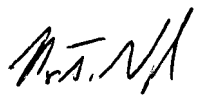
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele K. Joike, Ph.D. whose telephone number is 571-272-5915. The examiner can normally be reached on M-F, 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele K Joike, Ph.D.
Examiner
Art Unit 1636


NANCY VOGEL
PRIMARY EXAMINER